

REMARKS/ARGUMENTS

Page 2 of the Office communication dated Dec. 28, 2006 says: "The reply filed on 10/6/06 is not fully responsive to the prior Office Action because of the following omissions(s) or matters(s): The reply does not present arguments pointing out the specific distinctions believed to render newly presented claim 56 patentable over the applied references. See 37 CFR 1.111."

However, applicants' reply filed on 10/6/06 presented argument, evidence, and legal authority that the applied references (the "OSI Documents") were "not 'prior art' because they were not printed publications before the claimed invention by the applicants, nor were they printed publications more than a year prior to the Jan. 29, 2004 filing date of the present application for patent. Nor do the OSI documents show that the invention was known or used by others in this country, or in public use or on sale in this country, more than one year prior to the Jan. 29, 2004 filing date of the present application for patent." (Applicants' reply filed on 10/6/06, page 29 lines 9-18; page 36 lines 13-20; page 37 lines 5-12; page 38 lines 13-19.) As evidence thereof, applicants submitted a Rule 132 Declaration of Michael E. Hogan, and additional OSI documents regarding the development of the invention, as referenced in the Declaration of Michael E. Hogan, and cited on an Information Disclosure Statement. The applicants' reply filed on 10/6/06 also presented argument, evidence, and legal authority that the applicants are entitled to the benefit of the "experimental use doctrine" with respect to the applied references. (Applicants' reply filed on 10/6/06, page 31 line 1 to page 32 line 20.) The OSI "proposals and provision of services and flexible pipe joint prototypes to the oil production companies during the Erha and Thunder Horse projects were primarily for the purpose of

experimentation to perfect our invention and necessary for making our high temperature flexible pipe joint fit for actual use in a subsea environment.” (Rule 132 Declaration of Michael E. Hogan, paragraph 32 on page 21.)

The applicants’ asserted facts that none of the applied references are “prior art” are “specific distinctions” believed to render their newly presented claim 56 and claims 57-71 patentable over the applied references. In the absence of “prior art,” applicants are entitled to a patent. 35 U.S.C. 102, 103. Nor should 37 CFR 1.111 be construed to require any more “specific distinctions” between the applicants’ newly presented claims and the applied references when applicants have replied with a showing that none of the applied references are “prior art.” For example, 37 CFR 1.111 should not preclude the well-established practice of an applicant responding to a rejection under 35 U.S.C. 102(e) over an applied reference patent of another by the applicant submitting a Rule 131 declaration “swearing behind” the filing date of the patent and the applicant voluntarily copying the claims of the patent. See M.P.E.P. 711.02(b)(A) on page 700-181 (Rev. 5, August 2006)(copy attached).

In a typical case, it may not be possible for an applicant to point out any differences between the applicant’s claims and the subject matter disclosed in the applicant’s proprietary development documents relied upon as objective evidence of patentability such as a long-felt need and commercial success. However, in the present case, in view of applicants’ objective evidence of patentability such as a long-felt need and commercial success, the applicants believe that their new claim 56 is patentable over the applied references (the “OSI Documents”) due to the specific distinctions of “conveying production fluid greater than 180°F in a subsea

environment” in combination with “the polymeric material contacts the end portion of the central pipe to place the laminated elastomeric flex element in an initial state of compression.”

For example, page 12 of the OSI Document “Crazyhorse 12-In. Import Flexjoint Design” (Ref. C54, Exhibit E) entitled “Thermal Considerations” and subtitled “Design Limitations” says “Current OSI FlexJoints are rated for 180° maximum operating temperature” and “Major concerns include Flex Element esastomer bond, mechanical, fatigue life and aging properties”. Page 14 entitled “Thermal Considerations” and subtitled “Crazyhorse Thermal Barrier Concept” shows a steel cover welded over thermal barrier material. Page 17 says that one of the functions of the cover is “Protect Thermal Barrier Form [*sic.*] Chemical and Abrasion Breakdown.”

Page 4 of the OSI Document “Exxon-Erha FlexJoint Preliminary Design Summary” (Ref. C52, Exhibit C) says “Primary Concern with Fluid Temperature” and page 5 says “Existing FlexJoint compounds were not formulated to withstand long duration high temperature.” Page 7 indicates that testing is needed. Page 8 indicates that “New Compound Development” is a material option. Page 15 shows a metal cover welded or bonded over a thermal barrier. Page 20 says “Alternative approach may use a half dovetail locking feature in combination with high temperature epoxy adhesive.”

The OSI Document “Thunder Horse 12” HPHT SCR FlexJoint Design Summary (Ref. C56, Exhibit G) shows in Figure 5-53 a Final Thermal Barrier Configuration without a metal cover and refers to analysis of the thermal barrier design to predict initial and 25 year service conditions. A schematic drawing in Appendix A shows polymeric material contacting the end portion of the central pipe. However, there is no disclosure of placing the laminated elastomeric

flex element in an initial state of compression by the polymeric material contacting the end portion of the central pipe.

It is not possible to predict, with a high level of confidence, the performance of elastomeric flex elements under conditions of temperature, pressure, temperature loading, and deflection beyond the limits already proven by testing of a full-scale prototype under the actual conditions. In practice a high level of confidence that the elastomeric flex element will not fail is required so that the hydrocarbon production fluid will not be released into the subsea environment. (Rule 132 Declaration of Michael E. Hogan, paragraph 28 on pages 17-18.)

Please note that the applicants amended and added claims in order to more clearly distinguish the prior art cited in the European search reports (Refs. C1 and C2 submitted with applicants' information disclosure statement filed May 27, 2005; see also lines 7-8 on page 36 of applicants' reply filed on 10/6/06). In particular, the applicants' claims were amended to more clearly distinguish Angel U.S. 4,273,363; Herbert et al. U.S. Pat. 4,076,284; and Schwemmer U.S. 4,183,556. The most pertinent, Angel U.S. 4,273,363, was discussed in paragraph 9 on pages 4-5 of the Rule 132 Declaration of Michael E. Hogan. Applicants amended claims 1, 33, and 48 distinguish this prior art primarily by further defining the laminated elastomeric flex element to "shift strain from the inner elastomer layers to the outer elastomer layer" in a way or configuration that is not suggested by this prior art. Applicants' new claim 56 distinguishes this prior art by the specific configuration and orientation of the heat shield in the flexible pipe joint as summarized on page 27 lines 23-20 of applicants' reply filed on 10/6/06.

In view of the above, reconsideration is respectfully requested, and early allowance is earnestly solicited.

Ser. No. 10/767,587
Reply to Office communication

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Richard C. Auchterlonie". The signature is fluid and cursive, with the first name being the most prominent.

Richard C. Auchterlonie
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Attn: Office of Petitions

Telephone inquiries with respect to this matter should be directed to the Office of Petitions Staff at (571) 272-3282. For more detailed information, see MPEP § 711.03(c).

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To pass on questions of abandonment, it is essential that the examiner know the dates that mark the beginning and end of the statutory period under varying situations. Applicant's reply must reach the Office within the set shortened statutory period for reply dating from the date stamped or printed on the Office letter or within the extended time period obtained under 37 CFR 1.136. (See MPEP § 710 to § 710.06.)

For a petition to withdraw a holding of abandonment based upon failure to receive an Office action, see MPEP § 711.03(c).

711.02(a) Insufficiency of Reply

Abandonment may result from a situation where applicant's reply is within the period for reply but is not fully responsive to the Office action. But see MPEP § 710.02(c). See also MPEP § 714.02 to § 714.04.

¶ 7.91 Reply Is Not Fully Responsive, Extension of Time Suggested

The reply filed on [1] is not fully responsive to the prior Office action because: [2]. Since the period for reply set forth in the prior Office action has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a).

The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date for reply set forth in an Office action. A fully responsive reply must be timely filed to avoid abandonment of this application.

Examiner Note:

- In bracket 2, set forth why the examiner considers there to be a failure to take "complete and proper action" within the statutory period.
- If the reply appears to be a *bona fide* attempt to respond with an inadvertent omission, do not use this form paragraph; instead use form paragraph 7.95.

711.02(b) Special Situations Involving Abandonment [R-3]

The following situations involving questions of abandonment often arise, and should be specially noted:

(A) Copying claims from a patent when not suggested by the U.S. Patent and Trademark Office does not constitute a reply to the last Office action and will not save the application from abandonment, unless the last Office action relied solely on the patent for the rejection of all the claims rejected in that action.

(B) An application may become abandoned through withdrawal of, or failure to prosecute, an appeal to the Board of Patent Appeals and Interferences. See MPEP § 1215.01 to § 1215.04.

(C) An application may become abandoned through dismissal of appeal to the Court of Appeals for the Federal Circuit or civil action, where there was not filed prior to such dismissal an amendment putting the application in condition for issue or fully responsive to the Board's decision. Abandonment results from failure to perfect an appeal as required by the Court of Appeals for the Federal Circuit. See MPEP § 1215.04 and § 1216.01.

(D) Where claims are suggested for interference near the end of the period for reply running against the application**. See MPEP Chapter 2300.

(E) < Where a continued prosecution application (CPA) under 37 CFR 1.53(d) is filed. See MPEP § 201.06(d) and § 711.01.

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(F) < Prior to a decision by the Board, an application on appeal that has no allowed claims may become abandoned when a **>Request for Continued Examination (RCE)< is improperly filed without the appropriate fee or a submission (37 CFR 1.114(d)) in the application. The filing of an RCE will be treated as a withdrawal of the appeal by the applicant. See MPEP § 706.07(h), paragraph X.

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(G) < When a reply to a final Office action is outstanding, an application may become abandoned if an RCE is filed without a timely submission that meets the reply requirements of 37 CFR 1.111. The filing of an improper RCE will not operate to toll the running of any time period set in the previous Office action for